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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) STL9274	
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, (571)273-8300 on <u>2-10-07</u> Signature <u>Shelley D. McCarthy</u> Typed or printed name <u>Shelley D. McCarthy</u>		Application Number 09/494,787	
		Filed January 31, 2000	
		First Named Inventor John A. Mount	
Art Unit 2182		Examiner Sorrell, Eron J.	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

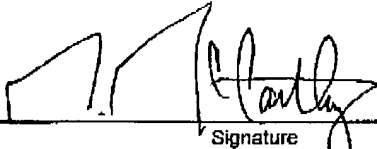
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 38,794

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


 Signature
Mitchell K. McCarthy
 Typed or printed name
(405) 601-2798
 Telephone number
2/10/2007
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 192. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1450.

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Transmission by Facsimile on February 10, 2007

**PATENT
Dkt. STL9274****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: **John A. Mount**
Assignee: **Seagate Technology LLC**
Filed: **January 31, 2000** Group Art: **2182**
Application No.: **09/494,787** Examiner: **Eron Sorrell**
For: **AUTOMATED REGISTER DATA TRANSFER TO REDUCE PROCESSING
BURDEN ON A PROCESSING DEVICE**

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APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The Panel is now faced with the task of determining whether the Examiner has factually supported the requisite *prima facie* case of non-patentable subject matter and the requisite *prima facie* case of anticipation. Applicant believes that the Panel, upon an objective review of the evidence set forth in the record as a whole, will reach the conclusion that this case is not in condition for appeal due to unresolved factual issues.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

I hereby certify that, on the date shown below, this correspondence is being:

☒ facsimile transmitted to the Patent and Trademark Office, (571) 273 - 8300,
TRANSMISSION

Date: 2/10/07

Shelley D. McCarthy
Signature

Shelley D. McCarthy
(type or print name of person certifying)

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IT IS REVERSIBLE ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED
A *PRIMA FACIE* CASE THAT CLAIM 16 RECITES NON-PATENTABLE SUBJECT
MATTER

USPTO personnel should review the totality of the evidence (e.g. the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. USPTO personnel must weigh the determinations made above to reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter. The Examiner bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); MPEP 2106(IV)(D).

Claim 16 recites a method comprising *providing data via a bus; updating at least one register or parameter via the bus; and providing data via the bus responsive to the updating*. The Panel will find evidence in the record supporting the conclusion that claim 16 recites patentable subject matter in accordance with Section 101:

1. Claim 16 plainly recites steps of providing data and updating a register over the same bus. (see Applicant's Response of 12/11/2006, pg. 10).

2. The skilled artisan readily recognizes claim 16 to be a recital of physical steps, not mere abstract steps. (see Applicant's Response of 7/24/2006, pg. 11).

3. The skilled artisan readily recognizes the utility of the recited steps of claim 16 as being associated with the reduced processing burden, as discussed in the specification at least in page 11, line 29 to page 12, line 3. (see Applicant's Response of 7/24/2006, pg. 11)

4. The Examiner has repeatedly admitted in the record that claim 16 recites eligible subject matter by rejecting it under Section 102 or 103 in four previous Office Actions. (see Applicant's Response of 12/11/2006 citing Office Actions of 3/16/2004, 11/5/2004, 5/12/2005, and 10/25/2005) Each examination goes to the merits of the claims both with respect to statutory compliance (i.e. eligible subject matter) and patentability. 37 CFR 1.104(a).

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The Panel will also find evidence in the record that none of the three different bases asserted by the Examiner for the Section 101 rejection meets the requisite burden for substantiating a *prima facie* case of non-patentable subject matter.

The Examiner's first basis was that claim 16 lies within a judicial exception to the statutory categories because "it can be easily construed as an abstract idea...." (Office Action of 1/24/2006 pg. 2) However, MPEP 2106 at that time stated "Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea...." Therefore, the Examiner's basis failed to meet the burden of establishing a *prima facie* case of non-patentable subject matter because it tacitly admitted that the claim could be construed otherwise (not solely as an abstract idea). (See Applicant's Response of 7/24/2006, pg. 11)

The Examiner's second basis was that claim 16 lies within a judicial exception to the statutory categories because it "lacks practical application because the claims have no concrete or useful application/result." (Office Action of 10/11/2006 pg. 2) However, MPEP 2106 clearly requires that in determining whether a practical application exists, "USPTO personnel first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or thing...If USPTO personnel find such a transformation or reduction, USPTO personnel shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. 101." MPEP 2106(IV)(C)(2) The skilled artisan readily recognizes that both recited steps of *providing data* and *updating at least one register* result in transformations of an article to a different state. Therefore, the Examiner's basis failed to meet the requisite burden of establishing a *prima facie* case of non-patentable subject matter because it wholly ignored the threshold requirement. Otherwise, Applicant obviated the Examiner's assertions that the claims recite no concrete or useful application/result. (see Applicant's Response of 12/11/2006 pg. 10-11)

The Examiner's third basis for the Section 101 rejection was that it is "an attempt to claim every practical application of updating a register over a bus, and is therefore preempting that abstract idea and non-statutory." (Advisory Action of 1/9/2007, pg. 2) However, MPEP 2106 clearly requires that "If USPTO personnel determine that the claimed invention preempts a 35 U.S.C. 101 judicial exception, they must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every

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substantial practical application thereof. MPEP 2106(IV)(C)(3) Therefore, the Examiner's basis failed to meet the requisite burden of establishing a *prima facie* case of non-patentable subject matter because it wholly ignored the requisite threshold requirement of explaining why the claim allegedly covers every practical application.

Applicant believes that the Panel, after considering the evidence in the record as a whole, can only reasonably conclude that the Examiner has failed to substantiate evidence in the record that it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter. Accordingly, the Panel is obliged to treat the rejection of claim 16 as reversible error, and as such not a bona fide matter for appeal. Withdrawal of the final rejection of claim 16 and the claims depending therefrom is respectfully requested.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF ANTICIPATION OVER HESSING '564 BY FAILING TO SUBSTANTIATE EVIDENCE THAT IT IDENTICALLY DISCLOSES ALL THE RECITED FEATURES OF INDEPENDENT CLAIMS 1, 16 AND 21

Independent claims 1, 16, and 21 recite steps for performing different functions via a common bus. Particularly, claim 1 recites retrieving first and second portions of recorded data and updating some registers via a common bus; claim 16 recites providing data and updating at least one register via a common bus; and claim 21 recites transmitting first and second data and updating at least one register via a common bus.

FIG.1 of Hessing '564 is helpful in understanding its disclosure.

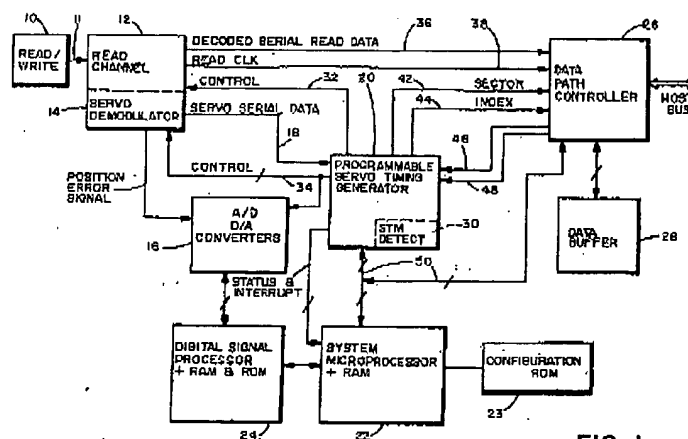


FIG. 1

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Particularly, Hessing '564 discloses transferring data between the read channel 12 and the data path controller 26 via a serial data bus formed by serial data path 36 and clock path 38. Hessing '564 further discloses passing data from ROM 23 to timing generator 20 to update registers 74, 76 via system bus 50. Accordingly, Hessing '564 explicitly discloses transferring data and updating registers via two separate buses, the serial data bus and the system bus, respectively. (see Applicant's Response of 12/11/2006, pg. 12; Applicant's Response of 7/24/2006, pg. 12)

However, the Examiner's rejection is based on his construction of the claim term *bus* to mean "all signal lines connecting items 12, 20, and 26." Applicant has pointed out in the record without rebuttal by the Examiner that this construction of *bus* must mean "any signal line connected to any one of the items 12, 20, and 26," because there is no signal path whatsoever that interconnects all three of the items, as would be in accordance with the ordinary and customary meaning of a *bus*. Applicant reiterates that the skilled artisan would view the Examiner's suggested meaning of *bus* to be absurd. (see Applicant's Response of 12/11/2006, pg. 13; Applicant's Response of 7/24/2006, ppg. 13-14) Accordingly, Applicant has pointed out in the record that the Examiner's claim construction is clearly erroneous and reversible error for being unreasonably broad because it ignores the plain meaning of the term *bus* consistent with its usage in the specification and the cited reference, thereby effectively ignoring explicitly recited claim terms. *In re Morris* 43 USPQ2d 1753 (Fed. Cir. 1997)

This case is not in condition for appeal due to the unresolved factual issue that the Examiner has not substantiated the anticipatory rejection by any evidence in the record whatsoever, and that the basis provided is clearly reversible error because it is based on an unreasonably broad construction of the recited claim language. This case is not ready for appeal until these factual issues are resolved. Withdrawal of the final rejection of claims 1, 16, and 21 and the claims depending therefrom is respectfully requested.

Respectfully submitted,

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